

REMARKS

This Response is in reply to the Examiner's comments set forth in the Office Action of March 4, 2010. Claims 50, 52-57, 59, 61-64, 66-67, and 75 are pending in the application. Claims 50, 52-57, 59, 61-63, 66-67, and 27 have been amended. Applicant asserts that the amendments proposed herein do not require any additional search by the Examiner and thus should be entered after final.

Reconsideration is requested in view of the comments and amendments herein.

I. The Office Action

Claims 67-69 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 49, 51-56-59, 61, 63-64 were rejected under 35 U.S.C. § 102(b) as being anticipated by US Patent No. 4,176,101 to Leslie et al. (hereinafter "Leslie").

Claims 49-62, 65, 66-78 were rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 6-70165 (corresponding to JP Appl. 61-278558) to Toray Industries, Inc. (hereinafter "Toray"), in combination with US 2002/0009564 to Hall et al. (hereinafter "Hall").

II. 35 U.S.C. 112, First Paragraph Rejection

Claims 67-69 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Office Action recites that the claimed L* value of "at least 54.47" encompasses a range of values that can be substantially higher than what is presented in the specification. Claim 67 has been amended to recite that the L* value is between about 54.47 and 85.50, which is properly supported in the specification. Accordingly, the rejection should be withdrawn.

III. Anticipation Rejection

Claims 49, 51-56, 59, 61, 63-64 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,176,101 to Leslie. It is submitted in the Office Action that Leslie discloses a parison and a bottle made from a composition containing PET, and this anticipates the subject claims because the claims do not require the presence of TiN. Independent claim 63, and similarly independent claim 61, have been amended to recite a container or a preform for a

container that comprises a composition that includes a polymeric material and titanium nitride, wherein the polymeric material includes 25ppm or less of titanium nitride based on the weight of the polymeric material. This amendment does not require the Examiner to perform an additional search, since the previously presented claims included up to 25 ppm TiN, and this necessarily required the Examiner to search for compositions including TiN. Moreover, claims 50, 52-57, and 59 have been amended to depend from claim 63, rather than claim 49; however, this does not affect the scope of the dependent claims, since claim 36 effectively specified a reduced TiN content that was previously covered in claim 49.

In light of the above, it is clear that the claims now explicitly require the presence of TiN. Accordingly, Leslie, which discloses a container pre-form and a bottle made only of PET and no TiN, does not anticipate the subject the claims.

IV. Inappropriate Combination of References

The Examiner further submits that although Toray does not teach products such as bottles or containers, Hall evidences that it is well known in the art that PET based compositions are used for production of a wide variety of end products, such as bottle/container performs. It is argued that since Hall discloses that “improved slip” characteristics are desirable for forming bottle performs, and Toray teaches this as an improvement, it would have been obvious for one of ordinary skill to use PET based compositions of Toray for making containers/performs since it is known that the same PET based compositions are used for both films and bottles and since Toray exhibits desirable characteristics. Applicant respectfully disagrees and asserts that Toray is clearly concerned with providing black compositions with a light blocking effect. Toray teaches that TiN is used because it has excellent dispersibility inside a polymer and has a light blocking effect. In contrast, Hall is directed to reducing static friction or “stiction” in transparent molded polyester articles. Hall teaches that in order to be acceptable for carbonated soft drink containers and the like, the PET polymer must meet strict specifications with respect to color (low haze), taste, odor, etc. Therefore, any additive must not alter these strict specifications. (See paragraph [0012]). Further, Hall explicitly recites, “silica and other similar fillers, when added to PET polymers, tend to increase haze in the blown bottles, and haze is particularly detrimental from an aesthetic standpoint.” (See paragraph [0016]). Since Toray teaches TiN as forming a black, color blocking polyester, which necessarily causes discoloration and haze, Toray and Hall are

mutually incompatible. Although the Examiner continues to combine the teaching of Hall with that of Toray, such a combination is without any motivation and ignores the very teachings of the references.

The Examiner submits that Applicants only concentrate on one part of the disclosure and not the portions relied upon by the Examiner, namely the improved slip properties in combination with the teaching that similar PET compositions are commonly used for films and bottle production. Applicant respectfully responds that the Examiner is required to consider a prior art reference in its entirety, including portions that would lead away from the claimed invention. (See MPEP 2141.02, citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983)). Here, simply because color and transparency may not be a desired characteristic for a container for a given application, Hall nonetheless states explicitly that haze is detrimental in transparent PET performs. Accordingly, any teaching of a filler (such as TiN in Toray resulting in L values at 14.0, 16.0, and 18.0, demonstrating a black color), that causes haze or reduces transparency is necessarily going to deter one skilled in the art away from using such a filler in Hall, regardless of any beneficial properties that may accompany such a filler.

V. Obviousness Rejection

Claims 49-62, 65, and 66-78 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Toray in view of Hall. Applicant respectfully submits that the rejection should be withdrawn for at least the following reason. Applicant respectfully submits that Toray and Hall do not, individually or in combination, teach or suggest the pending claims.

The majority of claims rejected by the Examiner in this instance, namely claims 50, 52-57, 59, and 66-67, have been amended to depend from independent claim 63, which is not included under this rejection. This is because neither Toray nor Hall teach or suggest a container or perform for a container comprising a polymeric material and TiN in an amount of less than 25ppm. Rather, Toray teaches that TiN can be added in amounts of 0.05-10% (or 500ppm-10,000ppm), or preferably, in amounts of 0.01-20% (or 100ppm-200,000ppm). As acknowledged by the Examiner, Toray expressly discloses that advantages can be realized by adding as little as 100 ppm of TiN; however, there is absolutely no teaching or suggestion of any potential benefits with lower amounts, particularly below 25ppm as is presently claimed.

For at least the aforementioned reasons, Applicant submits that the subject claims distinguish patentably over the references of record. As such, the rejection should be withdrawn.

CONCLUSION

For the reasons detailed above, it is respectfully submitted all claims remaining in the application (Claims 50, 52-57, 59, 61-64, 66-67, and 75) are now in condition for allowance.

Respectfully submitted,

Fay Sharpe LLP



June 1, 2010

Date

Scott A. McCollister, Reg. No. 33,961
Kimberly A. Textoris, Reg. No. 64,954
The Halle Building, 5th Floor
1228 Euclid Avenue
Cleveland, Ohio 44115-1843
216.363.9000